

REMARKS

I. Formalities

A telephonic interview was conducted on September 7, 2004, between Examiner Jefferey F. Harold of the United States Patent and Trademark Office and Applicant's representative, Andrew J. Taska. The interview was initiated by the Examiner.

Applicant's representative and the Examiner discussed whether additional amendments were be needed to expedite prosecution of the present application. Accordingly, entry of this Supplemental Amendment is respectfully requested.

The Examiner still has not yet indicated, in writing, whether the Formal Drawings filed on November 25, 1998 are accepted, as requested by Applicant in the Amendment filed on February 4, 2004. Applicant notes that on June 24, 2002, the Examiner stated in response to a telephone inquiry that no corrections to the drawings were required. In addition, the Examiner stated that he would clarify in writing that no objection to the drawings has been made. Accordingly, Applicant respectfully requests that the Examiner formally acknowledge and approve the aforementioned Formal Drawings.

II. Status of the Application

By the present Amendment, claims 5, 8, 12, and 14 have been amended. No new matter has been added and support for these amendments may be found in the present Specification, for example, at page 7, line 23 – page 8, line 27. Claims 2-17 are all the claims pending in the Application, with claims 5, 7, 8, 10-12, and 14 being in independent form.

The Examiner has rejected claims 2, 5, 8-9, and 12-14 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,011,976 to Michaels et al. (hereinafter “Michaels”). The Examiner has also rejected claims 3 and 6 under 35 U.S.C. § 103(a) as being obvious over Michaels in view of U.S. Patent No. 5,764,731 to Yablon (hereinafter “Yablon”).

The present Amendment addresses each point of objection and rejection raised by the Examiner. Favorable reconsideration is respectfully requested.

III. Allowable Subject Matter

Applicant thanks the Examiner for indicating that claims 4, 7, and 10-11 are allowed.

IV. Claim Rejections – 35 U.S.C. § 102

The Examiner has rejected claims 2, 5, 8-9, and 12-14 under 35 U.S.C. § 102(e) as being anticipated by Michaels. Applicant traverses this rejection for *at least* the reasons stated below.

According to the MPEP, “a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” See MPEP § 2131. Applicant respectfully submits that claims 2, 5, 8-9, and 12-14 positively recite limitations which are not disclosed (or suggested) by Michaels.

The present Application is directed, *inter alia*, to a process for transmitting a telephone number of a desired subscriber from a directory enquiry facility to a terminal over a telecommunications network with a first channel for voice transmission and a second channel for data transmission, and a directory enquiries facility and a terminal for this process. In particular, independent claims 5, 8, 12, and 14 of the present Application each recite that the first channel is configured for use with the second channel during a single telephone call.

A. Independent Claim 5

Independent claim 5 requires (among other things):

A process of transmitting a telephone number... over a telecommunication network with a first channel for voice transmission and a second channel for data transmission...

wherein the first channel is configured for use with the second channel during a single telephone call.

Michaels fails to disclose or suggest a first channel for voice transmission and a second channel for data transmission, wherein the first channel is configured for use with the second channel during a single telephone call, as recited in Applicant's claim 5. In contrast to the requirements of claim 5, Michaels discloses that a subscriber may obtain a telephone number from an operator-assisted directory enquiries system by first initiating a voice call to the network directory enquiries system and by thereby giving the operator certain information. *See* column 4, lines 17-21. In particular, the grounds of rejection allege that the "channel" over which such a voice call enquiry is transmitted, as disclosed in Michaels, corresponds to a first channel, as recited in claim 5.

Furthermore, according to Michaels, once the operator locates the desired number, the subscriber may then choose to receive the located number verbally, or over SMS ("Short Message Service") via a SIM ("Subscriber Identity Module") update. *See* column 4, lines 21-25. Specifically, the grounds of rejection allege that the "channel" over which such SMS messages are transmitted corresponds to a second channel, as required by claim 5.

However, in contrast to the requirements of claim 5, Michaels clearly discloses that, if the subscriber chooses to receive a number over SMS via a SIM update, the voice call initiated by the subscriber is terminated and, subsequently, the operator initiates the SMS process. *See* column 4, lines 25-28. Thus, Michaels does not disclose, and is incapable of suggesting, that the voice call (i.e., the alleged first channel) and the SMS update through which the desired number is transmitted (i.e., the alleged second channel) are configured for use with the second channel during a single telephone call, as required by claim 5. In fact, Michaels discloses just the opposite—that the operator initiates the SMS process (i.e., communication over the alleged second channel) only after the voice call is terminated (i.e., after communication over the alleged first channel is terminated). *See* column 4, lines 25-28. As a result, Michaels does not disclose, and is incapable of suggesting, a first channel for voice transmission and a second channel for data transmission, wherein the first channel is configured for use with the second channel during a single telephone call, as required by claim 5.

In contradistinction to Michaels, a first channel configured for use with a second channel during a single telephone call, as recited in claim 5, enables, for example, several telephone numbers to be extracted in one call to the directory enquiry facility. *See* page 8, lines 12-14. Additionally, such a configuration permits, for example, interaction between the terminal and the directory enquiry facility during a call, in which a user can initiate a message to the directory enquiry facility, after receipt of a telephone number, to request further information or additional telephone numbers from the directory enquiry facility. *See* page 8, lines 18-67.

Thus, Applicant respectfully submits that independent claim 5 is patentably distinguishable over (i.e., is not readable on) Michaels for *at least* these reasons. Further,

Applicant respectfully submits that dependent claims 2-3, 6, and 15-17 are allowable, *at least* by virtue of their dependency on claim 5. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

B. Independent Claim 8

Independent claim 8 requires (among other things):

A directory enquiry facility comprising:

receiver means for connecting to a terminal over a telecommunication network on a line with a first channel for voice transmission and a second channel for data transmission...

wherein the first channel is configured for use with the second channel during a single telephone call.

Michaels fails to disclose a directory enquiry facility comprising a receiver means for connecting to a terminal on a line with a first channel for voice transmission, and a second channel for data transmission, wherein the first channel is configured for use with the second channel during a single telephone call, as recited in Applicant's claim 8.

With respect to claim 8, the Examiner alleges that the network directory enquiries system disclosed in Michaels corresponds to the directory enquiry facility as recited in Applicant's claim 8. In contrast, *at least* for reasons analogous to those discussed above with respect to claim 5, Michaels discloses that the operator initiates the SMS process (i.e., initiates communication over the alleged second channel) only after the voice call is terminated, and that SMS messages (e.g., the desired number) can be received by a mobile telephone whenever it is idle or on stand-by. See column 1, line 20-21. Consequently, Michaels does not disclose, and is incapable of

suggesting, a receiver means for connecting to a terminal on a line with a first channel for voice transmission, and a second channel for data transmission, wherein the first channel is configured for use with the second channel during a single telephone call, as recited in Applicant's claim 8.

Thus, Applicant respectfully submits that independent claim 8 is patentably distinguishable over Michaels for *at least* these reasons. Further, Applicant respectfully submits that dependent claim 9 is allowable, *at least* by virtue of its dependency on claim 8.

Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

C. Independent Claim 12

Independent claim 12 requires (among other things):

A directory enquiry facility comprising:

a receiving module configured to receive from a terminal connected to a telecommunication network, with a line with a first channel for voice transmission and a second channel for data transmission...

wherein the first channel is configured for use with the second channel during a single telephone call.

In view of the similarity between this requirement and the requirement discussed above with respect to independent claim 8, Applicant respectfully submits that the foregoing arguments as to the patentability of independent claim 8 apply at least by analogy to claim 12. As such, it is respectfully submitted that claim 12 is patentably distinguishable over Michaels for *at least* these reasons. Further, Applicant submits that the dependent claim 13 is allowable *at least* by virtue of its dependency on claim 12. Thus, the allowance of these claims is respectfully solicited of the Examiner.

D. Independent Claim 14

Independent claim 14 requires (among other things):

A terminal in a telecommunication network comprising:

a connecting module configured to connect over the telecommunication network to a directory enquiry facility on a line with a first channel for voice transmission and a second channel for data transmission...

wherein the first channel is configured for use with the second channel during a single telephone call.

With respect to claim 14, the Examiner alleges that mobile 6 and SIM card 7, as disclosed in Michaels, correspond to a terminal in a telecommunications network comprising a connecting module and a memory, as recited in Applicant's claim 14. Applicant respectfully disagrees with the Examiner and submits that Michaels fails to disclose a connecting module configured to connect to a directory enquiry facility on a line with a first channel for voice transmission and a second channel for data transmission, wherein the first channel is configured for use with the second channel during a single telephone call, as required by claim 14.

In contrast, Michaels discloses that the operator initiates the SMS process only after the voice call is terminated and that SMS messages (e.g., the desired number) can be received by a mobile telephone whenever it is idle or on stand-by. Consequently, Michaels does not disclose, and is incapable of suggesting, a first channel for voice transmission, and a second channel for data transmission, wherein the first channel is configured for use with the second channel during a single telephone call, as recited in Applicant's claim 14.

Thus, Applicant respectfully submits that independent claim 14 is patentably distinguishable over Michaels for *at least* these reasons. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

V. Claim Rejections – 35 U.S.C. § 103

The Examiner has rejected claims 3 and 6 under 35 U.S.C. § 103(a) as being obvious over Michaels in view of Yablon. This rejection is respectfully traversed.

In order for the Examiner to maintain a rejection under 35 U.S.C. § 103, Michaels, Yablon, or a combination thereof, must teach all of the limitations of claims 3 and 6. Applicant respectfully submits that neither Michaels, Yablon, nor any combination thereof, teaches or suggests all of the limitations of claims 3 and 6.

Claims 3 and 6 incorporate all the novel and non-obvious features of their base claim 5. As explained above with respect to claim 5, Michaels does not disclose a first channel for voice transmission and a second channel for data transmission, wherein the first channel is configured for use with the second channel during a single telephone call. In fact, Michaels teaches quite the opposite—that the operator initiates the SMS process only after the subscriber's voice call is terminated. Accordingly, Michaels is incapable of teaching or suggesting the novel limitations of base claim 5. Furthermore, Yablon also fails to teach or suggest this feature.

Therefore, claims 3 and 6 would not have been obvious from Michaels, Yablon, or any combination thereof, for *at least* these reasons. Accordingly, Applicant respectfully requests that the Examiner withdraw this rejection.

VI. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

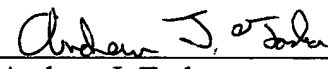
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